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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PETERSON, KENNETH E	

ART UNIT	PAPER NUMBER
3724	

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/533,685	HEARN, MICHAEL LEE	
	Examiner	Art Unit	
	Kenneth E. Peterson	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-30,33-38 and 40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-30,33-38 and 40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Claims 25 and 36 are objected to because of the following informalities:

On line 2 of claim 25, "continuous", first occurrence, should be deleted.

On line 2 of claim 36, "the a" should be changed to –the--.

Appropriate correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 22,26 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Bussey, III et al.'827, who shows a perforating device in figure 4 having all of the recited limitations including a first cylinder (51) having a first segmented blade (52 or 52').

As seen in figure 4, the nipping surface (surface of roller 51) extends from the sides of the blade.

Also shown is a first anvil cylinder (45) made of bristles. Note in figure 4 that the bristles press against the web, and thus Bussey meets the requirement for compressing the web as set forth in the board decision.

In regards to claim 26, the cutting cylinder is a two-part metallic hub as seen in figure 8, with an inner part and an outer part.

4. Claims 22,26,28,30,33 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolfberg et al.'497, who shows a perforating device in figure 10 having

all of the recited limitations including a first cylinder (112) having a first and second segmented blade (114) and a second cylinder (104) having another segmented blade (108).

As seen in figure 10 the nipping surface (surface of roller 114) extends from the sides of the blade.

Also shown is a first anvil cylinder (116) and a second anvil cylinder (106). Note in figure 10 that the anvils and cutting cylinders contact the web being cut. The device is CAPABLE of receiving web thicker than that shown. Any web thicker than that shown would inherently be compressed and gripped as it passes thru, and thus Wolfberg has the structure to meet the requirement for compressing the web as set forth in the board decision. Applicant is reminded that Wolfberg need not disclose this intended use step for compressing the web, he need merely show the structure capable of performing it. MPEP 2111.02 has an excellent discussion on how intended use statements (e.g. compressing a web) must be given weight as structure but not given weight as a method step. Perhaps the best example is the *Schreiber* case, where an oil can was successfully used to reject a popcorn dispenser based on CAPABILITY, even though there was zero suggestion to dispense popcorn. Likewise, Wolfberg is CAPABLE of compressing a web of certain thickness at the nip, even though there is no suggestion to do so. Also worth reading is MPEP 2114 "MANNER OF OPERATING DEVICE DOES NOT DIFFERENTIATE APARATUS CLAIM FROM THE PRIOR ART".

Examiner notes that the Board has overturned a previous 102 rejection by Wolfberg. However, the Board has not considered the claims as now amended, and the board also has not seen the new interpretation based on capability.

In regards to claims 26 and 28, the cutting cylinders and anvils are both two-part metallic hubs. Each has a left part and a right part.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 22,26,28 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown '410 in view of Jesperson '431.

Brown shows a cutter with most of the recited limitations including a first cutting roller (16) having a blade (94) that extends past the nipping surface.

Also shown is a first anvil cylinder (18). The cutter and anvil are drawn together by springs, so Brown meets the requirement for compressing the web as set forth in the board decision.

In regards to claims 26 and 28, the cutting cylinder has at least two metal parts as seen in figure 11 and the anvil has at least two metal parts as seen in figure 11.

Brown's blade is not a perforating blade with spaced cutting edges. However, it is well known for dispensers of this type to employ perforating blades so that the product hangs on, ready to be ripped off by a user when needed. An example of this is

the patent to Jesperson (138, figure 2). It would have been obvious to one of ordinary skill in the art to have modified Brown by making his blade a perforating blade, as taught by Jesperson, so that the cut product would hang on until needed by the user.

7. Claims 22,26,28,30,33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcus '481 in view of Wolfberg et al.'497.

Marcus shows a cutter with most of the recited limitations including a first cutting roller (14) having a blade (34) that extends past the nipping surface (40,46). Note that surfaces 40 and 46 do extend circumferentially to a small extent, and that the claims do not require they extend all the way around the cylinder.

Also shown is a first anvil cylinder (12). The web is compressed by the resiliency of the nipping surface (40,46), so Marcus meets the requirement for compressing the web as set forth in the board decision.

Marcus's blade is not a perforating blade with spaced cutting edges. However, it is well known for machines of this type to employ perforating blades so that a large numbers of products can be rolled together, shipped, and later detached by the user. An example of this is the patent to Wolfberg. It would have been obvious to one of ordinary skill in the art to have modified Marcus by making his blade a perforating blade, as taught by Wolfberg, so that the cut products could be shipped together until needed by the user.

In regards to claim 36, Marcus does not show a second cutting cylinder and second anvil. However, this is well known as shown by Wolfberg. It would have been

obvious to one of ordinary skill in the art to have provided Marcus with a second cutting cylinder and second anvil, as taught by Wolfberg, in order to increase the number of perforations one can make, and to increase the flexibility in where the perforations can be placed on the web.

In regards to claims 26 and 28, the cutting cylinder and anvil are both two-part metallic hubs. Each has a left part and a right part.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bussey III et al.'827 in view of Henc '312 or Sauer '762.

If it is argued that Bussey's cutting cylinder is not a "two piece metallic hub", then Examiner notes that this is common in the art. For example, see Henc '312 or Sauer '762. It would have been obvious to one of ordinary skill in the art to have modified Bussey by making the cutting cylinder be a "two piece metallic hub", as taught by Henc and Sauer and many others, in order to be able to assemble them about their shafts without having to remove the shaft from it's bearing set.

9. Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfberg et al.'497 in view of Henc '312 or Sauer '762.

If it is argued that Wolfberg's cutting cylinder and anvil are not "two piece metallic hubs", then Examiner notes that this is common in the art. For example, see Henc '312 or Sauer '762. It would have been obvious to one of ordinary skill in the art to have modified Wolfberg by making the cutting cylinder and anvil be "two piece metallic hubs",

as taught by Henc and Sauer and many others, in order to be able to assemble them about their shafts without having to remove the shaft from it's bearing set.

10. Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcus '481 in view of Wolfberg et al.'497 and further in view of Henc '312 or Sauer '762.

If it is argued that Marcus's cutting cylinder and anvil are not "two piece metallic hubs", then Examiner notes that this is common in the art. For example, see Henc '312 or Sauer '762. It would have been obvious to one of ordinary skill in the art to have modified Marcus by making the cutting cylinder and anvil be "two piece metallic hubs", as taught by Henc and Sauer and many others, in order to be able to assemble them about their shafts without having to remove the shaft from it's bearing set.

11. Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown '410 in view of Jesperson '431 and further in view of Henc '312 or Sauer '762.

If it is argued that Brown's cutting cylinder and anvil are not "two piece metallic hubs", then Examiner notes that this is common in the art. For example, see Henc '312 or Sauer '762. It would have been obvious to one of ordinary skill in the art to have modified Brown by making the cutting cylinder and anvil be "two piece metallic hubs", as taught by Henc and Sauer and many others, in order to be able to assemble them about their shafts without having to remove the shaft from it's bearing set.

12. Claims 23,27,29,34,37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcus '481 in view of Wolfberg et al.'497 (with or with Henc '312 and Sauer '762) and further in view of Brown '914.

Marcus's stripper (40,46) is made from rubber materials (lines 27-30, column 5). However, it is well known for strippers like this to be made from urethane, as exampled by Brown. It would have been obvious to one of ordinary skill in the art to have made Marcus's stripper out of urethane, as taught by Brown, since it is an art recognized equivalent known for the same purpose.

13. Claims 24,25,35 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcus '481 in view of Wolfberg et al.'497 (with or with Henc '312 and Sauer '762) and further in view of Kirkpatrick, Jr. et al.'069.

Marcus's anvil is not a continuous layer of urethane. However, this is an extremely common feature. Hundreds of references can be pulled showing urethane covered anvil rollers. For example, see Kirkpatrick (lines 52,53, column 3). It would have been obvious to one of ordinary skill in the art to have further modified Marcus by making the anvil of the type taught by Kirkpatrick, since urethane covered anvils have high cut and tear resistance as well as healing properties (again, Kirkpatrick's lines 52,53, column 3).

14. Claims 23,24,27,29,34,35 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown '410 in view of Jesperson '431 (with or without Henc '312 and Sauer '762) and further in view of Irsik '512.

Brown, as modified, shows a cutter with all of the recited limitations except the 1st cutting cylinder nipping surface is not mentioned to be urethane. On line 47 of column 3, Brown states that the surfaces should be "*rubber or resilient matrix*". The purpose of Brown's surface is clearly to facilitate advancement of the material. The courts have long held that it is obvious to select a material based upon it's known qualities. In this case, Irsik shows that it is well known for cylinders to employ urethane (line 22, column 3) for it's nip surfaces (30,32). It would have been obvious to one of ordinary skill in the art to have modified Brown by making the nipping surface out of urethane, as taught by Irsik, in order to firmly advance the material and also accommodate different thickness materials (Irsik's lines 24,25, column 3). Since this urethane is clearly resilient, it would also perform Brown's desired functions.

15. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

As seen above, the breadth of the claims has lead to numerous new rejections being applied. Examiner is confident that Applicant can come up with *structural* amendments to distinguish over the prior art (particularly Bussey and Marcus). Applicant is warned not to try to import items from the specification into the claims. As seen from the past history of the case, this only prolongs prosecution and results in

different rejections being applied, accompanied by a muddied case history. Attempts to distinguish over the prior art rejections should involve amending the claims to add *structure.*

To make the case history more clear, it is suggested that Applicant add the phrase "*such that the web is compressed in the nip so the web does not move or slip with respect to the cylinders*" to the independent claims. This would make the interpretations of the Applicant, Board and Examiner more understandable to future viewers.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth E. Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

kp

KENNETH E. PETERSON
PRIMARY EXAMINER